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10/765,467	01/26/2004	Roberto Cosciani	08029.0025U1	8589
23859	7590	02/25/2005	EXAMINER	
NEEDLE & ROSENBERG, P.C. SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			PARSLEY, DAVID J	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/765,467

Applicant(s)

COSCIANI, ROBERTO

Examiner

David J Parsley

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **Detailed Action**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains legal phraseology in particular the term "means" in lines 2 and 3. Correction is required. See MPEP § 608.01(b).

### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of prior U.S. Patent No. 6,591,539 to Cosciani. This is a double patenting rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 13 and 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the arm" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the arm linkage" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the wings" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 18-23 depend from rejected claim 17 and include all of the limitations of claim 17 thereby rendering these dependent claims indefinite.

Claim 24 recites the limitation "the drive shaft" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 depends from rejected claim 24 and include all of the limitations of claim 25 thereby rendering this dependent claim indefinite.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,412,209 to Kaprally et al.

Referring to claim 1, Kaprally et al. discloses a decoy having a body – at 14, and a movement system – see figure 7, for causing the decoy to move, the movement system comprising guide means – at 16, connected to the body and drive means – at 44, for driving the guide means so as to impart movement to the body in at least two directions simultaneously – see for example figures 1-3 where the head of the body moves both in a downward direction and in a direction towards the right/rear of the body and the tail of the body moves upward and towards the left.

Referring to claim 2, Kaprally et al. discloses the guide means comprises a guide element – at 50, and guide track – at 48 and 60-72, for receiving the element – see for example figure 7, wherein the drive means is adapted to drive the guide track and guide element – see for example figure 7.

Referring to claim 4, Kapraly et al. discloses the guide track is fixed to a pivot – proximate 28, so that the arm – at 46, imparts an oscillatory motion to the guide track – see for example figures 1-3.

Referring to claim 15, Kapraly et al. discloses the movement system is mounted on flotation means – at 14, thereby allowing the decoy to operate on water – see figures 1-3.

Referring to claim 16, Kapraly et al. discloses the decoy is affixed directly to the movement system – see for example figures 1-5.

Referring to claim 17, Kapraly et al. discloses a base of the decoy – at 14, is connected directly to the guide element – see for example figures 1-5.

Claims 1-6, 8-10, 14 and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,574,902 to Conger.

Referring to claim 1, Conger discloses a decoy having a body – at 12, and a movement system – at 22-62, for causing the decoy to move, the movement system comprising a guide means – at 22-36, connected to the body – see figures 1-3, and drive means – at 60, for driving the guide means so as to impart movement to the body in at least two directions – see for example figures 1-2.

Referring to claim 2, Conger discloses the guide means comprises guide element – at 26 or 22-24, and guide track – at 22-24 or 30-38, 62, for receiving the element, wherein the drive means is adapted to drive the guide track and guide element.

Referring to claim 3, Conger discloses the drive means comprises a rotary motor – at 60, and an output arm – see figure 2a, adapted to be received by the guide track – at 62, whereby the rotary motion of the arm imparts a linear motion to the guide track – see for example figures 1-2.

Referring to claim 4, Conger discloses the guide track is fixed to a pivot – at 20,24, so that the arm – proximate 60, imparts an oscillatory motion to the guide track – see for example figures 1-3.

Referring to claim 5, Conger discloses the guide track further comprises a slot – proximate 62, for receiving the output arm – see for example figures 1-2, to protrude therethrough to cause the guide element to move relative to the guide track – see for example figures 1-2.

Referring to claim 6, Conger discloses the guide element – at 26, is pivotally connected to the guide track – see figures 1-2, and wherein the output arm – proximate 62, moves along a path on the guide element to cause the guide element to move in an oscillatory manner about the pivot – see for example figures 1-2.

Referring to claim 8, Conger discloses the output arm – proximate 62, is engaged by the guide element – at 22-24 or 26, to cause it to move to and fro along the guide track – see for example figures 1-2.

Referring to claim 9, Conger discloses the guide element – at 22, further comprises a protruding portion – see figure 3, extending transversely and adapted to move along an edge of the guide track – at 30,36, the edge being profiled to cause the protruding portion and part of the guide element to move relative to the guide track in a direction corresponding to the profile – see for example figures 1-3.

Referring to claim 10, Conger discloses the protruding portion is positioned to the rear of the guide element – see figures 1-3, and the edge is profiled to cause the rear of the guide element to rise relative to the front of the guide element as it moves towards the front of the

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guide track and to be lowered in the return direction so as to simulate a feeding motion for the body – see for example figures 1-3.

Referring to claim 14, Conger discloses the movement system is mounted on means to allow it to stand on solid ground – see at 38, 42 in figure 1.

Referring to claim 24, Conger discloses a method of imparting movement to a decoy – at 12, wherein rotary movement of the drive shaft – proximate 60, is converted to linear movement – at 30,36, and oscillatory motion of a pivoted guide element – at 14-24, which guide element is driven within a guide track – at 24,30,36 by drive means – at 60 – see for example figures 1-3.

Referring to claim 25, Conger discloses a decoy having a body – at 12, and a movement system – at 22-62, for causing the decoy to move, the movement system comprising a guide means – at 22-36, connected to the body – see figures 1-3, and drive means – at 60, for driving the guide means so as to impart movement to the body in at least two directions – see for example figures 1-2.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapraly et al. as applied to claims 2 or 3 above, and further in view of Conger.



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Referring to claim 3, Kaprally et al. further discloses the drive means comprises a rotary motor – at 44, and an output arm – at 46, adapted to be received by the guide track – at 48.

Kaprally et al. does not disclose the rotary motion of the arm imparts a linear motion to the guide track. Conger does disclose the rotary motion of the arm – proximate 60, imparts a linear motion to the guide track – at 30. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Kaprally et al. and add the linear movement of the guide track of Conger, so as to allow for the device to depict the actual movement of an animal.

Referring to claim 5, Kaprally et al. does not disclose the guide track further comprises a slot for receiving the output arm to protrude therethrough to cause the guide element to move relative to guide track. Conger does disclose the guide track further comprises a slot – proximate 62, for receiving the output arm – see for example figures 1-2, to protrude therethrough to cause the guide element to move relative to the guide track – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Kaprally et al. and add the slot of Conger, so as to allow for the device to depict the actual movement of an animal.

Referring to claim 6, Kaprally et al. as modified by Conger further discloses the guide element – at 26, is pivotally connected to the guide track – see figures 1-2 of Conger, and wherein the output arm – proximate 62, moves along a path on the guide element to cause the guide element to move in an oscillatory manner about the pivot – see for example figures 1-2 Conger.

Referring to claim 7, Kaprally et al. as modified by Conger further discloses the guide element and body move from a horizontal plane in upward and downward directions about the

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pivot to simulate a nodding motion of the decoy – see for example figures 1-3 of Kapraly et al. and figures 1-2 of Conger.

Referring to claim 8, Kapraly et al. as modified by Conger further discloses the output arm – at 46, is engaged by the guide element – at 50, to cause it to move to and fro along the guide track – see for example figures 1-3 of Kapraly et al.

Referring to claim 9, Kapraly et al. as modified by Conger further discloses the guide element – at 22, further comprises a protruding portion – see figure 3 of Conger, extending transversely and adapted to move along an edge of the guide track – at 30,36, the edge being profiled to cause the protruding portion and part of the guide element to move relative to the guide track in a direction corresponding to the profile – see for example figures 1-3 of Conger.

Referring to claim 10, Kapraly et al. as modified by Conger further discloses the protruding portion is positioned to the rear of the guide element – see figures 1-3 of Conger, and the edge is profiled to cause the rear of the guide element to rise relative to the front of the guide element as it moves towards the front of the guide track and to be lowered in the return direction so as to simulate a feeding motion for the body – see for example figures 1-3 of Conger.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger as applied to claim 6 above, and further in view of Kapraly et al. Conger further discloses the body moves from a horizontal plane in upward and downward directions about the pivot to simulate a nodding motion of the decoy – see for example figures 1-2. Conger does not disclose the guide element moves in a nodding motion. Kapraly et al. does disclose the guide element – at 50, moves in a nodding motion – see for example figures 1-3. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Conger and add the guide element moving

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in a nodding motion, so as to allow for the device to be compact and move in a motion mimicking an animal.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapraly et al. or Conger as applied to claim 1 above, and further in view of U.S. Patent No. 2,953,869 to Collischan.

Referring to claim 11, Kapraly et al. and Conger both do not disclose the decoy further comprises one or more wings connected to the body, and the movement system further comprises means to facilitate oscillatory motion of the or each wing. Collischan does disclose the decoy further comprises one or more wings – at 40,41, connected to the body, and the movement system further comprises means – at 42-70, to facilitate oscillatory motion of the or each wing – see for example figures 1-4 and columns 2-3. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Kapraly et al. or Conger and add the moving wings of Collischan, so as to allow for the device to simulate the movement of bird.

Referring to claim 12, Kapraly et al. as modified by Collischan and Conger as modified by Collischan, further disclose the means to facilitate oscillatory motion is provided by the guide element – at 65-68, of the movement system further comprising a toothed rack – at 7-23, to engage a cog arrangement – at 7-23, secured to the guide track – at 63, and connecting the or each wing to cause it or them to move in an oscillatory motion – see for example figures 1 and 4 of Collischan.

Referring to claim 13, Kapraly et al. as modified by Collischan and Conger as modified by Collischan, further disclose the guide element is connected by an arm – at 70 to the or each wing – at 40,41, the or each wing being pivoted about a point – at 42,43, spaced from the arm

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linkage – see figures 1 and 4, to convert linear motion of the guide element to oscillatory motion of the or each wing – see for example figures 1 and 4 of Collischan.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaprally et al. as applied to claim 17 above, and further in view of Collischan.

Referring to claim 18, Kaprally et al. does not disclose the wings of the decoy are arranged to move in a generally vertical plane, the guide element being connected to the wings through an arrangement of wire or rods. Collischan does disclose the wings – at 40,41, of the decoy are arranged to move in a generally vertical plane – see figures 1 and 4, the guide element – at 65-68, being connected to the wings through an arrangement of wire or rods – at 70 – see figures 1-4. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Kaprally et al. and add the moving wings of Collischan, so as to allow for the device to simulate the movement of bird.

Referring to claim 19, Kaprally et al. as modified by Collischan further discloses the wires or rods engage mounting points internally within the body of the decoy – see for example at 70 in figures 1 and 4 of Collischan.

Referring to claim 20, Kaprally et al. as modified by Collischan further discloses motion of the guide track – at 63, causes respectively a lengthening or shortening of the wires or rods to effect motion of the wings – see for example figures 1 and 4 of Collischan.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaprally et al. as modified by Collischan as applied to claim 20 above, and further in view of U.S. Patent No. 5,901,491 to Caldwell. Kaprally et al. as modified by Collischan does not disclose the form of an owl decoy. Caldwell does disclose an owl decoy – see for example figures 1a-1b. Therefore it

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would have been obvious to one of ordinary skill in the art to take the device of Kapraly et al. as modified by Collischan and add the owl decoy of Caldwell, so as to allow for the device to be used to deter pests.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapraly et al. as modified by Collischan and Caldwell as applied to claim 21 above, and further in view of U.S. Patent No. 5,989,091 to Rodgers.

Referring to claim 22, Kapraly et al. as modified by Collischan and Caldwell do not disclose simulated eyes which are adapted to illuminate and switching of the illumination is effected by motion of the guide element. Rodgers does disclose simulated eyes – at 14, which are adapted to illuminate – see for example columns 1-2, and switching of the illumination is effected by motion of the guide element – see for example columns 1-5. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Kapraly et al. as modified by Collischan and Caldwell and add the lighted eyes of Rodgers, so as to allow for the device to be seen in the dark.

Referring to claim 23, Kapraly et al. as modified by Collischan, Caldwell and Rodgers further discloses the guide element during motion is adapted to engage a microswitch – at 58, see for example figures 1-5 and columns 5-6 of Kapraly et al.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The following patents are cited to further show the state of the art with respect to moving decoy assemblies in general:

U.S. Pat. No. 364,573 to Brinkop – shows decoy apparatus

U.S. Pat. No. 2,849,823 to Miller – shows decoy apparatus

U.S. Pat. No. 5,098,050 to Bruns et al. – shows decoy apparatus

U.S. Pat. No. 5,233,780 to Overholt – shows movable decoy

U.S. Pat. No. 5,377,439 to Roos et al. – shows decoy apparatus

U.S. Pat. No. 5,392,554 to Farstad et al. – shows decoy apparatus

U.S. Pat. No. 5,775,022 to Sumrall et al. – shows decoy apparatus

U.S. Pat. No. 5,884,427 to Lenz – shows decoy apparatus

U.S. Pat. No. 5,941,008 to Schmidt et al. – shows decoy apparatus

U.S. Pub. No. 2002/0152666 to Solomon – shows decoy apparatus

U.S. Pat. No. 6,748,690 to Igo – shows decoy apparatus

U.S. Pat. No. 6,760,993 to Lebens – shows decoy apparatus

U.S. Pat. No. 6,834,458 to Hand et al. – shows decoy apparatus

GB 2067064 – shows decoy apparatus


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on 9hr compressed.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DP  
David Parsley  
Patent Examiner  
Art Unit 3643

  
**PETER M. POON**  
**SUPERVISORY PATENT EXAMINER**  
2/22/05